

REMARKS

Applicant has carefully reviewed the Application in light of the Advisory Action mailed March 22, 2005. At the time of the Office Action, Claims 1-33 were pending in the Application. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 103 Rejections

The Examiner rejects Claims 1-17, 23-28, and 30-33 under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent No. 6,646,997 issued to Baxley et al. (hereinafter “*Baxley*”) in view of U.S. Patent No. 5,369,694 issued to Bales et al. (hereinafter “*Bales*”). The Examiner rejects Claims 18-22 under 35 U.S.C. § 103(a) as being unpatentable over *Baxley* in view of U.S. Patent No. 6,671,262 issued to Kung et al. (hereinafter “*Kung*”). The Examiner rejects Claim 29 under 35 U.S.C. § 103(a) as being unpatentable over *Baxley* and *Bales* as applied to Claim 28 above, and further in view of U.S. Publication No. 2003/0125954. Applicant respectfully traverse these rejections for the reasons stated below.

Applicant respectfully reminds the Examiner that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations. (See M.P.E.P. §2142-43.) It is respectfully submitted that Claim 1 is patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation.

Independent Claim 1 recites a method for conducting a transfer of a conference call that includes receiving a message at a media gateway to transfer responsibility for mixing of the media streams from a first call resource to a second call resource and communicating a prompt to the clients during the transfer of responsibility for mixing of the media streams if the message indicates a change in the number of clients participating in the conference call, the prompt operable to mask the transfer of responsibility for mixing of the media streams between the first and second call resources.

Baxley discloses a large-scale, fault-tolerant audio conferencing system in a packet-switched network. (See Abstract of *Baxley*.) However, *Baxley* fails to offer any prompt, as is recited in Independent Claim 1. The Examiner readily concedes this point (See Current Office Action: page 4); ergo *Bales* makes an appearance in the Office Action in order to fill this void. At the portion of *Bales*, which is relied on by the Examiner, the following is provided: "Next, block 703 causes notify messages to be sent to the other station sets on the meet-me-conference call, advising them of the fact that the station set 101 is now part of the meet-me-conference call. Finally, block 704 returns control to terminal manager application 305." (See *Bales* at Column 9, lines 1-5.)

Thus, *Bales* sends a simple notify message in the context of a meet-me-conference call. For a number of reasons, this notify message is clearly not akin to the prompt of the pending claims. First, the Examiner should understand that there are two data signals, which are present in the architecture of the present invention: 1) a message; and 2) a prompt. The Examiner should also appreciate that Independent Claim 1 deals with a method for conducting a transfer of a conference call. This method includes receiving *a message* to transfer responsibility for mixing of the media streams from a first call resource to a second call resource. Note that during the transfer of responsibility for mixing of the media streams, if the message indicates a change in the number of clients participating in the conference call, then *a prompt* is communicated. Hence, the Examiner should further appreciate that there is a condition present for the prompt to be communicated. Finally, the prompt in the present invention has a purpose and that purpose is different from the one espoused by the Specification of *Bales*. As identified in Independent Claim 1, the prompt is operable to mask the transfer of responsibility for mixing of the media streams between the first and second call resources. It should be noted once again that all of these operations are being executed in the context of a transfer of a conference call.

Hence, *Bales* cannot inhibit the patentability because it fails to offer any disclosure of a prompt, as this issue has been evaluated extensively above. Moreover, such a 'notify message' of *Bales* appears to be somewhat irrelevant because of the environment in which the present invention operates, as compared to the environment of *Bales*. For at least these reasons, Independent Claim 1 is clearly patentable over the proffered *Bales-Baxley* combination.

Independent Claims 6, 10, and 14 recite limitations similar, but not identical, to those recited in Independent Claim 1. Therefore, these claims are also allowable, for example, for the same reasons as identified above. Additionally, the corresponding dependent claims from these Independent Claims are also patentably distinct for analogous reasons.

Moreover, *Bales* is inherently flawed, as it is being used out of context (e.g. for prompts that it does not have or for delays it could not implement). This has been explained thoroughly by the Applicant. Applicant also notes that the Examiner is yet to even examine Independent Claim 33, which he is required to do: particularly if he has a penchant to respond to Applicant with a Final Action.

It is also noted that even if these elements were disclosed in the cited references, which they are not, usage of the *Bales* reference or of the proposed *Baxley-Bales* combination is still improper because the Examiner has not shown the required suggestion or motivation in *Baxley*, in *Bales*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.¹ Thus, the sheer fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.²

Nothing in *Baxley* or in *Bales* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests or motivates the proposed combination.³ This is because the references fail to include the above-identified functionality and, therefore, are precluded from rendering the pending claims unpatentable. Speculation in hindsight that “it would have been obvious” to make the proposed combination because the proposed combination would be helpful is insufficient under M.P.E.P.⁴ guidelines and governing

¹ M.P.E.P. §2143.01 (emphasis in original).

² *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

³ If “common knowledge” or “well known” art is being relied on to combine the references, Applicant respectfully requests that a reference be provided in support of this position pursuant to M.P.E.P. §2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. §2144.03.

⁴ See M.P.E.P. §2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

Federal Circuit case law.⁵ The M.P.E.P. consistently confirms that this approach is improper and, thus, it should not be used here.⁶ Moreover, under the M.P.E.P., such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on “subjective belief and unknown authority.”⁷ Under such circumstances, the Examiner must point to some concrete evidence in the record in support of the rejection, rather than relying on an assessment of what is “well recognized” or what a skilled artisan would be “well aware.”⁸

In the context of the second criterion of non-obviousness, the Examiner has also failed to show any potential interoperability of the two systems of *Bales* and *Baxley*: much less a reasonable expectation of success for the proposed combinations, as is required. Therefore, Applicant respectfully submits that the Examiner has also failed to establish the second criteria for a *prima facie* case of obviousness.

Therefore, the Examiner has not satisfied the criteria that is required to support a proper §103 rejection. All of the pending claims have been shown to be allowable over the references of record. Written notice to this effect is respectfully requested from the Examiner in the form of a full allowance of the pending claims.

⁵ For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). *See also In Re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”).

⁶ See M.P.E.P. §2145.

⁷ See *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

⁸ See *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001).

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant submits herewith a check in the amount of \$790.00 to satisfy the request for continued examination fee of 37 C.F.R. §1.17(e). If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,
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